

**REMARKS**

The Examiner's indication of allowable subject matter of claims 15-17, 19 and 25-27 is noted with appreciation.

All claims, including the rejected claims, remain unchanged notwithstanding the Examiner's new grounds of rejection.

The Examiner's statement in paragraph 6 of the Office Action that the arguments advanced in the previous Amendment are moot in view of the new grounds of rejection, is noted. Applicants respectfully disagree because, at least, the argument found in the Amendment filed August 8, 2003, page 10, first paragraph; that *Humphrey* teaches away from having freely rotatable or idler rollers in his system, is not moot. This argument will be repeated herein below for the Examiner's convenience of review.

The 35 U.S.C. 103(a) rejection of claims 12-14, 18, 20-24, and 28-31 as being obvious over *Humphrey* in view of *Schmitz* and in further view of *Paavola* is noted. It appears that the Examiner has replaced the previously applied reference of *Moore*, which fails to teach free rotating rollers, with *Schmitz*, which allegedly teaches such rollers. However, the Examiner appears to have missed the main point of Applicants' argument that *Humphrey* cannot properly be modified to include freely rotatable or idler rollers in his system because *Humphrey* teaches away from such a modification.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success

must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP, section 2143 (emphasis added).

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). See MPEP, section 2145 (emphasis added).

As to the independent claims, *Humphrey* teaches away from a combination with any reference (be it *Moore* or *Schmitz* or any other reference) that uses idler rollers to tension the wrapping film. In the "Background of the Invention" section of the *Humphrey* patent, a conventional system (FIG. 8 of *Humphrey*) has been heavily criticized for its use of idler rollers 82 and 84. *Humphrey* explicitly teaches that disadvantages of the conventional system can be avoided by driving the pre-stretching rollers with a motor so that the speed of the rollers can be controlled. See the description of FIG. 9 of *Humphrey* in column 11, especially lines 22-25 and 44-45, of the patent. Thus, the *Humphrey* reference, when considered as a whole, would have led a person of ordinary skill in the art away from the claimed structure which utilizes freely rotatable rollers as pre-stretching rollers.

For this reason alone, the 35 U.S.C. 103(a) rejection manifested in paragraph 3 of the Office Action is inappropriate and should be withdrawn.

In addition, the Examiner's argument in the last sentence of page 3 of the Office Action that it would have been obvious to combine *Humphrey* with *Schmitz* and *Paavola* for the purpose of increasing operational efficiency appears inaccurate. First, it is unclear from the language of the Office Action as to where such a suggestion or motivation to combine can be found, i.e., in the references themselves or in the knowledge generally available in the art. Clarification is respectfully requested. Second, according to *Humphrey*, a system using the rollers of *Schmitz* would have a number of serious problems mentioned in column 4, lines 54-57 of *Humphrey*. Thus,

the Examiner's combination of *Humphrey* and *Schmitz* is not deemed to increase operational efficiency at all. In fact, such a combination appears to decrease operational efficiency and, apparently, would not have been made by a person of ordinary skill in the art.

For this additional reason, the 35 U.S.C. 103(a) rejection manifested in paragraph 3 of the Office Action is inappropriate and should be withdrawn.

The 35 U.S.C. 103(a) rejection of claims 18 and 29 as being obvious over *Humphrey* in view of *Schmitz* and in further view of *Paavola* and *Min* is noted. This rejection is traversed for the reasons advanced above with respect to their independent claims. This rejection is also traversed because, again, *Humphrey* teaches away from having the claimed helical spring in his system.

In the "Summary of the Invention" section of the *Humphrey* patent, *Humphrey* specifically requires that a constant force applying mechanism be coupled to the dancer to maintain the constant force as the dancer swings back and forth. See column 6, lines 59-61 and element 38 of *Humphrey*. According to the Examiner's official notice, it is well known that the spring force of a spring varies over the distance of deformation. A person of ordinary skill in the art upon reading column 6, lines 59-61 of *Humphrey*, would at once have recognized that a spring with a varying spring force cannot be used as the constant force applying mechanism in the *Humphrey* system, and has been excluded from consideration by *Humphrey*. The person of ordinary skill in the art would also have recognized that replacing the original constant force applying mechanism of *Humphrey* with a varying spring force spring would render the *Humphrey* system unsatisfactory for its intended purpose of maintaining the biasing force on the dancer. See column 6, lines 57-61 of *Humphrey*. Therefore, the person of ordinary skill in the art would not have been motivated to combine *Humphrey* with *Min* in the manner the Examiner proposes.

For this additional reason, the 35 U.S.C. 103(a) rejection manifested in paragraph 4 of the Office Action is inappropriate and should be withdrawn.

Applicants would like to remind the Examiner that he should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. See *MPEP*, section 706.07. Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. See *MPEP*, section 707.07(f).

Accordingly, if any of the rejections manifested in the outstanding Office Action is to be sustained, the Examiner is requested to specify the reason(s) why Applicants' arguments are not persuasive and/or why the rejections stand.

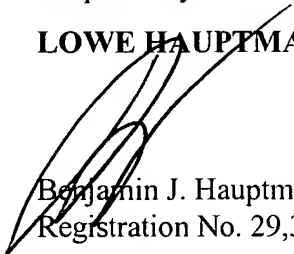
Each of the Examiner's rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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